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EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

13

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 13

Application Number: 10/057,719
Filing Date: 1/25/02
Appellant(s): GARSKE

MAILED

DEC 23 2003

GROUP 3700

Peter C. Maki
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/14/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1,3,9,11,12, and 13 as a group; claims 22 and 23 as a group; claims 25-27 as a group; claims 29 and 30 as a group; and claims 8, 20, 24, and 28 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|-----------|---------|---------|
| 5,362,171 | Hageman | 11-1994 |
| 2,206,804 | Boyd | 1-1989 |
| 355,171 | Crocker | 8-1931 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

CFR 1.192(c)(7) and (c)(8).

Claims 1, 9, 11, 12, 22, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd in view of Browne '018 (Browne). This rejection is set forth in prior Office Action, Paper No. 9.

Claims 3, 13, 20, 23, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1, 9, 11, 12, 22, 25, 27, and 29 above and further in view of Hageman. This rejection is set forth in prior Office Action, Paper No. 9.

Claims 8, 24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crocker in view of Browne. This rejection is set forth in prior Office Action, Paper No. 9.

(11) Response to Argument

Appellant's first argument is that there is no suggestion to combine the teachings of Browne with Boyd. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Browne clearly teaches making cylindrical golf hole liners of one piece and that this construction makes it easy to install the liner (See Col. 5, lines 40-45).

The ordinarily skilled artisan would recognize that Browne's clear teaching of the ease of insertion of such a construction would offer an advantage over that disclosed by Boyd because it eliminates the step of having to make sure that the edges of 12 and 13 abut properly and do not overlap to any extent.

Appellant's assertion that such a construction would not have suggested itself because it would be harder to remove is unsupported and thus must be considered speculation in contrast to Browne's clear teaching that such a construction makes it easy to insert in the hole.

As to appellant's particular reason for the construction claimed, (to keep dirt from getting through the seam) it must be remembered that it is not required that the prior art be combined for the reasons which motivated appellant to construct the device. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990).

Regarding the "purpose and use and design requirements" of Browne's liner versus Boyd's and whether they are directed to analogous problems the examiner is not asserting that they are identical in function. However, both are used for the purpose of lining a golf hole and both are concerned with providing a highly visible target that is

replaceable as desired to maintain this visibility. Thus one of ordinary skill in the art considering the teachings of one would clearly consider the teachings of the other.

Appellant's argument (page 11, second paragraph) that making Boyd's liner seamless would render it unsatisfactory for its intended purpose is not persuasive. The reversibility of a cylindrical device such as that taught by Boyd in view of Browne would have been a function of the length of the cylinder and the flexibility of the plastic. The ordinarily skilled artisan is not presumed to work in a vacuum and one of ordinary skill in the art wishing to maintain this particular function of Boyd would clearly have tailored these two parameters of the cylinder accordingly. Moreover, this is not the purpose of Boyd's device. The particular function referenced by applicant is an aside near the end of the disclosure and is not a claimed part of the device.

Appellant's next argument is that one considering Boyd in view of Browne's teaching would arrive at some other device. However, it appears that this argument is premised on what one would find obvious considering Browne in view of the teachings of Boyd. This is not the rejection at hand. Appellant's further argument that the real problem is that dirt gets behind the liner only strengthens the rationale for the combination of references. Browne is specifically directed at this problem - it is used to hold back dirt. Thus, the ordinarily skilled artisan considering the art as a whole would recognize the advantage of a seamless device preventing the passage of dirt when considering the problems of a device which allowed the passage of dirt such as Boyds.

Concerning the argument over secondary considerations appellant's declaration and evidence of commercial success have been noted and carefully considered. The

sales shown by the appellant are impressive but are only a part of the considerations which have to be weighed in trying to determine obviousness under 35 U.S.C. 103. Office policy is to follow *Graham v. John Deere Co.* 383 U.S. 1, 148 USPQ 459 (1966) in the consideration and determination of obviousness under 35 U.S.C. 103. Under *Graham* four factual inquiries enunciated therein form a background for determining obviousness as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

While applicant's submissions regarding commercial success (element D) have been given their full weight, the other three elements of *Graham* are, in the examiner's opinion, so persuasive as to obviousness, that the claimed invention cannot be considered unobvious.

With regard to appellant's comments on claims 20, 22, 25, and 29 on page 13 of the brief, no new arguments are presented and therefore the examiner's response is the same as above.

Concerning the argument over the Hageman reference presented at the bottom of page 13 of the brief and on page 14, Hageman has been cited merely to teach that such inserts may be inserted below a lip to hold the insert in place in the cup and that an insert of shorter length may be used. The appellant has not challenged these teachings of Hageman as applied to Boyd in view of Browne.

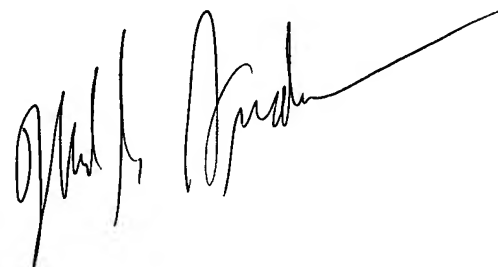
Appellant's final argument pertains to the rejections based on Crocker in view of Browne. Appellant's only argument is that one considering Crocker in view of Browne's teaching would arrive at a device that does not reach into the cup. However, it appears that this argument is premised on what one would find obvious considering Browne in view of the teachings of Crocker. This is not the rejection at hand. Crocker clearly discloses an insert extending into the cup itself.

Regarding the motivation to combine, it is again pointed out that Browne provides a clear motivation at Col. 5, lines 40-45.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham
Primary Examiner
Art Unit 3711



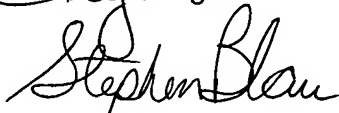
MSG
December 19, 2003

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